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10/044,260	01/11/2002	David Emery Virag	PU 020010	7877

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EXAMINER
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CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 05/07/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/044,260

Applicant(s)

VIRAG ET AL.

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. This Office action is responsive to the amendments filed 4/14/04 and 3/24/04. The 3/24/04 is entered in part, i.e. only the amendment to the specification and remarks have been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The amendment filed 3/24/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: new paragraph added after line 26 at page 12 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. Claims 10-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is inadequately written to provide support for claims 10-13 in that the specification only discloses two separate embodiments the first being the directory assistance embodiment and the second being a voice mail embodiment (see page 10 lines 12-32). There is no single integrated embodiment which discloses

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directory assistance service and voice mail service working together as one to provide both directory assistance and voice mail services as is claimed, therefore the specification is inadequately written to provide support for claims 10-13.

5. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 103(a) as being obvious over Smith, Jr. et al (US PAT. NO. 6,603,839 filed 9/13/2000, hereinafter Smith) in view of Gerszberg et al (US PAT. NO. 5,949,474 hereinafter Gerszberg).

Smith discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 12, note PDA, PC, etc.) having a display for viewing textual directory information, the device connected to a telephone network (not shown but inherent), a database application which includes directory information (e.g. see directory assistance database in Fig. 12 and its corresponding descriptions), a mechanism (e.g. the directory organization software and its associated keys) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information (e.g. see all figures). Note entire patent. Smith differs from the claimed invention in not disclosing the telecommunication device being connected to a DSL telephone network.

However, it is old and well known in the art for telecommunication devices to connect to a DSL telephone network communication medium, for example see Gerszberg col. 3 line 52, col. 5 lines 16-17 which discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 3A) having a display for

viewing textual information, the device being connected to a DSL telephone network (e.g.) to access a database since DSL provides for faster and more data throughput. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smith's telecommunication device to be connected to a DSL telephone network to access the remote database since it is old and well known in the art that DSL provides greater data transmission capacity and speed, e.g. provide faster access and data retrieval from the remote database.

6. Claims 6, 7, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as modified by Gerszberg as applied to claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al (US PAT. NO. 6,269,337 filed 7/1998 hereinafter Desmond).

Regarding claims 6, 20, Smith as modified by Gerszberg differs from the claimed invention in not disclosing the directory information includes business hours of an entry. However, it is notoriously old and well known in the art that a user of directory assistance services often wants to know additional information such as business hours, etc. (e.g. see Desmond col. 1 lines 33-38), and Desmond teaches a directory service which also provides the user with additional information associated with the entry such as business hours. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smith as modified by Gerszberg to provide additional information associated with the entry such as business hours to satisfy the needs of the user.

Regarding claims 7, 21, Desmond teaches that the listed (entry) party is charged a fee for this additional information service (e.g. col. 2 lines 15-20), this obviously is a priority, preference criteria as claimed since it is the preference, priority of the listed party to pay a fee to be listed in the same manner as disclosed by applicants.

7. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 103(a) as being obvious over Braun et al (US PAT. NO. 5,524,141, hereinafter Braun) in view of Gerszberg et al (US PAT. NO. 5,949,474 hereinafter Gerszberg).

Braun discloses a telecommunication method and system comprising a telecommunication device (e.g. figures 1, 4, or ADSI interface and TV or the ADSI phone) having a display for viewing textual directory information, the device connected to a telephone network (300), a database application which includes directory information (e.g. see directory service unit 200 and its corresponding descriptions), a mechanism (e.g. keys on the ADSI phone or the remote control) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information (e.g. see all figures). Note entire patent. Braun differs from the claimed invention in not disclosing the telecommunication device being connected to a DSL telephone network.

However, it is old and well known in the art for telecommunication devices to connect to a DSL telephone network communication medium, for example see Gerszberg col. 3 line 52, col. 5 lines 16-17 which discloses a telecommunication method

and system comprising a telecommunication device (e.g. figure 3A) having a display for viewing textual information, the device being connected to a DSL telephone network (e.g.) to access a database since DSL provides for faster and more data throughput. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Braun's telecommunication device to connected to a DSL telephone network to access the remote database since it is old and well known in the art that DSL provides greater data transmission capacity and speed, e.g. provide faster access and data retrieval from the remote database.

8. Claims 6, 7, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun as modified by Gerszberg as applied to claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al (US PAT. NO. 6,269,337 filed 7/1998 hereinafter Desmond).

Regarding claims 6, 20, Braun as modified by Gerszberg differs from the claimed invention in not disclosing the directory information includes business hours of an entry. However, it is notoriously old and well known in the art that a user of directory assistance services often wants to know additional information such as business hours, etc. (e.g. see Desmond col. 1 lines 33-38), and Desmond teaches a directory service which also provides the user with additional information associated with the entry such as business hours. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Braun as modified by Gerszberg to

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provide additional information associated with the entry such as business hours to satisfy the needs of the user.

Regarding claims 7, 21, Desmond teaches that the listed (entry) party is charged a fee for this additional information service (e.g. col. 2 lines 15-20), this obviously is a priority, preference criteria as claimed since it is the preference, priority of the listed party to pay a fee to be listed in the same manner as disclosed by applicants.

9. Claims 1-5, 8, 9, 14-19 are rejected under 35 U.S.C. 103(a) as being obvious over Schlachman et al (US PAT. NO. 6,504,925 filed 3/15/94, hereinafter Schlachman) in view of Gerszberg et al (US PAT. NO. 5,949,474 hereinafter Gerszberg).

Schlachman discloses a telecommunication method and system comprising a telecommunication device (10) having a display for viewing textual directory information, the device connected to a telephone network (14), a database application which includes directory information (e.g. 12 in Fig. 1, see col. 5 lines 46-65), a mechanism (e.g. keys on the telecommunication device) coupled to the telecommunication device to provide the user with access when the mechanism is activated to provide directory information to the display of the telecommunication device in response to user entered text information (e.g. see all figures). Note entire patent. Schlachman differs from the claimed invention in not disclosing the telecommunication device being connected to a DSL telephone network.

However, it is old and well known in the art for telecommunication devices to connect to a DSL telephone network communication medium, for example see



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Gerszberg col. 3 line 52, col. 5 lines 16-17 which discloses a telecommunication method and system comprising a telecommunication device (e.g. figure 3A) having a display for viewing textual information, the device being connected to a DSL telephone network (e.g.) to access a database since DSL provides for faster and more data throughput. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schlachman's telecommunication device to connected to a DSL telephone network to access the remote database since it is old and well known in the art that DSL provides greater data transmission capacity and speed, e.g. provide faster access and data retrieval from the remote database.

10. Claims 6, 7, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlachman as modified by Gerszberg as applied to claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al (US PAT. NO. 6,269,337 filed 7/1998 hereinafter Desmond).

Regarding claims 6, 20, Schlachman as modified by Gerszberg differs from the claimed invention in not disclosing the directory information includes business hours of an entry. However, it is notoriously old and well known in the art that a user of directory assistance services often wants to know additional information such as business hours, etc. (e.g. see Desmond col. 1 lines 33-38), and Desmond teaches a directory service which also provides the user with additional information associated with the entry such as business hours. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schlachman as modified by Gerszberg to

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provide additional information associated with the entry such as business hours to satisfy the needs of the user.

Regarding claims 7, 21, Desmond teaches that the listed (entry) party is charged a fee for this additional information service (e.g. col. 2 lines 15-20), this obviously is a priority, preference criteria as claimed since it is the preference, priority of the listed party to pay a fee to be listed in the same manner as disclosed by applicants.

11. Applicants' arguments with respect to claims 1-9, 14-21 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 3/24/04 have been fully considered but they are not persuasive.

Applicants' remarks regarding claims 10-13 have been fully considered but they are not persuasive. As clearly stated in the specification page 10 lines 12-20, for example, which explicitly stated the voice mail embodiment is "an alternate embodiment", therefore the specification clearly distinguishes the voice mail and directory services as two separate and different embodiments, there is no single integrated embodiment which discloses directory assistance service and voice mail service working together as one to provide both directory assistance and voice mail services as is claimed. The specification may provide disclosure for both service separately only, but there is no written disclosure that the two works together in a single

embodiment, therefore contrary to applicants' erroneous allegations there is no written support for claims 10-13 as claimed. Applicants' remarks that the claims recited a single integrated embodiment are clearly erroneous. This is evidenced by the fact that claim 10 was originally an independent claim directed to the voice mail embodiment separate from independent claims 1 and 14 which are directed to a directory service embodiment; as such the originally filed claim 10 fail to disclose an integrated embodiment which discloses directory assistance service and voice mail service working together as one to provide both directory assistance and voice mail services as is claimed. Furthermore, claim 10 was amended to depend from claim 1 only after a restriction requirement given by the Office, therefore this further evidence that this change to claim 10, i.e. amending claim 10 to become dependent claim 10, is CLEARLY NOT a dependent claim that is originally filed and is not part of the specification as originally filed. The cited sections also fail to remedy this deficiency, the cited sections also refer to the two embodiments separately. The cited section, p. 10, lines 19-20 only stated "the voice mail server works in much the same way as the directory services application described therein", and this does not mean that the voice mail server and the directory services application are integrated as one embodiment, this merely states the two embodiments work "in much the same way". Therefore, contrary to applicants' erroneous allegations the specification is in adequately written to provide support for a single integrated embodiment which discloses directory assistance service and voice mail service working together as one.

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lund (US PAT. NO. 6,104,789) discloses a method and system for transmitting text messages from a caller to a subscriber.

Montalbano (US PAT. NO. 5,838,775) discloses the communication network can be a PSTN, Internet, packet-switched network or ATM-based [DSL] network.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is 703-305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.



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WFC  
5/4/04